

### REMARKS

Applicants have carefully reviewed this Application in light of the Office Action mailed March 13, 2009. At the time of the Office Action, Claims 27-42 are pending in this Application. Claims 1-26 were previously canceled without prejudice or disclaimer. Claims 27-42 were rejected. No claims are hereby amended. Applicants respectfully request reconsideration and favorable action in this case.

#### **Rejections under 35 U.S.C. § 103**

Claims 27-32 and 37-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over International Application No. WO9833343 issued to Marja-Leena Lehmus et al. ("*Lehmus*") in view of U.S. Patent No. 7,155,417 issued to David J. Sagar et al. ("*Sagar*")

Claim 33 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehmus* in view of *Sagar* and further in view of U.S. Patent 6,907,239 issued to Timo E. Sivula ("*Sivula*").

Claims 34-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehmus* in view of *Sagar* and further in view of U.S. Patent 6,967,011 issued to Arnaud Capitant ("*Capitant*").

Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehmus* in view of *Sagar* and further in view of *Capitant* and still further in view of *Sivula*.

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S. Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S. Ct. at 1741.

Claims 27-32 and 37-42

Regarding claim 27 a first premise of the rejection is that “Lehmus teaches a method for providing pre-paid services over a radio communication network to a telecommunication device comprising a user identification circuit.” (OA at 3). Claim 39 is similarly rejected because Lehman allegedly teaches “an apparatus that allocates pre-paid services.” (OA at 4). This premise of the rejection fails because Lehmus does not disclose or even suggest providing “pre-paid services.” Examples of “pre-paid services” are claimed in claim 33, wherein “the service is at least one of mobile email, instant messaging, video telephony, a multimedia messaging service and a short message service.” Lehmus simply does not contemplate providing such pre-paid services, but rather relates to credit and debit card transactions (*see* Lehmus at 10:11-28) and right of access through a door or gate. (*see* Lehmus at 10:29-11:19). Thus, Lehmus fails to teach or suggest a method or apparatus for providing “pre-paid services” as claimed in claims 27 and 39.

A second premise of the rejection is that Lehmus teaches “communicating a user identification message from the user identification circuit to the telecommunication device.” Similarly, as to claim 39, a premise of the rejection is that Lehmus teaches “a telecommunication device (Figs. 1-3).” (OA at 4). This premise of the rejection fails because Lehmus does not disclose or even suggest the use of a “telecommunication device.” As claimed in claim 28, examples of the telecommunication device comprise a GSM device and a UMTS device.

In the method according to the invention for providing paying services within a radio communication network operating in particular in accordance with the “Global System Mobile” GSM standard or the “Universal Mobile Telecommunications System” UMTS standard, by means of at least one radio communication terminal comprising a device for user identification, in particular a “Subscriber Identity Module” SIM or “UMTS Subscriber Identity Module” USIM, and by means of at least one network control unit and at least one device for providing at least one service, when a request for one of the

services is made by the radio communication terminal, at least one message generated by the user identification device is transmitted to the network control unit or device for providing the services.

(Specification at [0019]). The specification expressly provides a Personal Digital Assistant as an example of a radio communication terminal or telecommunication device. "In the arrangement scenario of a UMTS system selected here, radio communication terminals can be operated solely using a user identification device USIM, where the radio communication terminal shown is embodied as a 'Personal Digital Assistant' PDA." (Specification at [0023]). Lehmus merely teaches a "first system J1" with which a subscriber identity module communicates. (see Lehmus at 8:25). Thus, Lehmus fails to teach or suggest "telecommunication device" as claimed in claims 27 and 39.

A third premise of the rejection is that Lehmus discloses "transmitting at least one service request message over the radio communication network from the user identification circuit to a service computer, wherein the at least one service request message requests allocation of at least one service (read as SMS or USSD message, Fig. 4c, Block 41 and Pg. 10, lines 29-37, and Pg. 11, lines 1-19)." (OA at 3). As similar rejection is made of claim 39. (OA at 4). As noted above, examples of the "at least one service" being requested include "mobile email, instant messaging, video telephony, a multimedia messaging service and a short message service," as claimed in claim 33. According to Lehmus, SMS or USSD messages simply request credit and debit card transactions (see Lehmus at 10:11-28) and right of access through a door or gate (see Lehmus at 10:29-11:19), but they do not request "allocation of at least one service," as claimed in claims 27 and 39.

A fourth premise of the rejection of claim 27 is that Lehmus discloses "receiving a pre-paid account status message over the radio communication network from the service computer to the user identification circuit in response to each service request message, wherein the user identification circuit evaluates the pre-paid account status message (read as server verifies user's creditworthiness so that prepaid card can be debited, Pg. 10, line 29-Pg. 11, line 13)." (OA at 3). A similar rejection is made of claim 39. (OA at 4). A pre-paid account status message is clearly explained.

After reception of the result, a fourth message A4 is sent from the station SERVER to the first application USAT\_APP, this fourth message A4 containing the result of the check, and the transaction identifier T-ID1. The result of the check can be indicated as text (string) in the form "credit OK", or

in the negative case "credit low", for example, or by straightforward setting of a defined bit of the fourth message A4.

Alternatively or additionally, more than just two decision levels are also possible, which can be used to inform the user also of the need to increase the credit with "credit OK, re-charge recommendation", for example, if the credit is only sufficient for the one service requested.

(Specification at [0033]-[0034]). Lehmus simply fails to disclose or suggest transmission of such a "a pre-paid account status message" as claimed in claims 27 and 39.

A fifth premise of the rejection of both claims 37 and 39 is that "Sagar clearly teaches communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result (Col. 1, lines 48-67)." (OA at 3 and 4). This premise fails because Sagar actually teaches away from "communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device." Sagar expressly teaches that "In a SIM-based prepaid system, the subscriber account balance or purse is stored on the SIM of the wireless handset." (Sagar at 1:54-55). Thus, Sagar simply fails to disclose or suggest "communicating the evaluated pre-paid account status message" as claimed in claims 27 and 39.

Because several premises of the rejection fail, the inventions as claimed in claims 27 and 39 are patentable in view of the combined teachings of Lehmus and Sagar. The inventions as claimed in the dependent claims are patentable for similar reasons.

#### Claim 33

Claim 33 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehmus* in view of *Sagar* and further in view of U.S. Patent 6,907,239 issued to Timo E. Sivula ("*Sivula*"). However, Sivula does not teach the elements of claim 27 identified as missing in the above discussion. Therefore, the invention as claimed in claim 33 is patentable in view of the combined teachings of Lehmus, Sagar and Sivula.

#### Claims 34-35

Claims 34-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehmus* in view of *Sagar* and further in view of U.S. Patent 6,967,011 issued to Arnaud Capitant ("*Capitant*"). However, Capitant does not teach the elements of claim 27 identified

as missing in the above discussion. Therefore, the invention as claimed in claims 34-35 is patentable in view of the combined teachings of Lehmus, Sagar and Capitant.

Claim 36

Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehmus* in view of *Sagar* and further in view of *Capitant* and still further in view of *Sivula*. However, Capitant and Sivula do not teach the elements of claim 27 identified as missing in the above discussion. Therefore, the invention as claimed in claims 36 is patentable in view of the combined teachings of Lehmus, Sagar, Capitant and Sivula.

**Association of Customer Number and Change of Correspondence Address**

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **86528**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **86528**. All telephone calls should be directed to counsel at 512.457.2026. A Revocation and Power of Attorney will be filed shortly.

**CONCLUSION**

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2030.

Respectfully submitted,  
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